

In the Drawings:

Please find enclosed herewith replacement drawings (9 sheets) which provide an improved quality of illustration. No new matter has been added. It is requested that these drawings be entered in replacement for those originally filed.

REMARKS:

A fresh Information Disclosure Statement is attached hereto which lists prior art cited on the corresponding PCT application, and a copy of the Search Report of the PCT office is attached for the convenience of the Examiner. The Examiner will note that the Search Report has only just been received and is dated 6th January 2006.

From the listed prior art on the Search Report, the Examiner will note that:

The first reference listed US 20050127602 is in fact the present application which therefore does not of course constitute prior art.

The second reference listed is CA 2421241 was filed only 6 months before the present application and was published only three months before the present application and therefore does not constitute prior art under 35 USC 102. This Canadian application corresponds to prior US application 10/394,570 which is commonly owned with the present application and thus cannot be cited as prior art under 35 USC 102.

The references of Such Canada, Sanderson and Such disclose constructions of break-open tickets which are not relevant to the packaging material of the present invention as discussed hereinafter.

New drawing sheets are filed herewith which provide an improved quality of illustration.

Claims 16 to 29 have been cancelled without prejudice. New claims 30 to 43 have been added so that the total number of claims has

remained unchanged. Claim 14 has been made independent so that there is now a total of five independent claims requiring a payment for two additional independent claim of $(2 \times \$200) = \400 . The requisite fee is hereby attached by money order.

The claims have been revised to slightly to delete the word "substrate" which is considered to be unclear which used with the term "sheet".

Claims 1 through 15 have been rejected under 35USC102 or 35USC103 on the basis of prior art of Evers. Evers discloses an insert piece which goes inside a cigarette package and which provides in a channel shape a bottom portion and two side walls which are connected at a line of perforations indicated for example at 43 and 45 in figures 4 and 5. A piece of the sheet is folded upwardly along a transverse fold line 41C as shown in figure 6 so that a top edge or top portion of this folded portion is visible within the package when the package is opened. This portion therefore is narrower than the fold lines and is shaped so that it projects above a cut out part of the remaining part of the insert.

In figures 8 and 9 an alternative arrangement is shown in which the fold line 41C extends across the full width of the structure so that the bottom portion also extends across the full width and into the side walls defined by the fold lines 43 and 45.

However the only connection between the folded sheet which is folded upwardly and the remainder of the insert is the fold line 41C. Also these sheets are of entirely different shape so that the portion 40A as best shown in

figure 9 projects upwardly beyond the top edge of the remainder so that it is visible.

The clear purpose of this exposed portion is explained in the summary of the invention in column 1 at line 55 wherein it states

“The initially lower portion extends above the normal front cut out of the inner frame where it cannot fail to be seen by the consumer when the lid of the pack is first opened.”

The summary further goes on to state that the intention is that there is a line of weakness between the visible portion and the remainder of the inner frame so that it can be torn away.

At the top of column 2 it states that

“The folded up portion (or at least that part which is beyond the above mentioned line of weakness) may be printed, embossed and/or debossed on either or both sides with any desired information.”

It is important therefore that this folded piece, which forms a coupon or the like, is exposed above the remainder of the inner liner so that it is readily available and accessible and **visible** when the pack is opened.

Claim 1 has now been amended to set forth

a) that the first and second sheets are coextensive “so as to define side edges and end edges of the first sheet which overlies side and end edges of the second sheet.”

And b) that the first and second sheets are connected “along the side and end edges by an adhesive strip to form a common assembly with a

hollow interior closed by the adhesive strips at the connected side and end edges".

Clearly Evers does not disclose such a construction since the two pieces are not connected by any adhesive strips along the overlying side edges and since the two pieces are **necessarily** not of the same shape so that they are not coextensive.

The Examiner has not cited any prior art in combination with Evers. The above feature is not disclosed in Evers and hence the rejection under 35USC102 cannot be sustained nor can the rejection under 35USC103 since it is an essential requirement of such a rejection that each and every limitation of the claim be shown in the prior art.

The Examiner will be aware of other prior art which shows components formed from two overlying sheets which are coextensive such as the prior art of Scrymgeour (US patent 6,234,477) and the further prior art of Sanderson or Such cited herein.

However such constructions cannot properly be combined with the clear disclosure of Evers since Evers clearly requires that the coupon piece be exposed above the edge of the remainder of the inner liner as clearly set forth above. Thus there would be no motivation to combine into the construction of Evers an arrangement where two pieces are coextensive since this would clearly cancel the intended operation of the Evers device and form a construction which is completely inconsistent with the construction of Evers.

It is submitted therefore that claim 1 as amended is now clearly distinguished from the prior art of Evers and should be allowed.

Turning now to claim 14, this claim is now an independent claim which includes many of the features of original claim 1.,

Claim 14 now includes the feature that

"The perforation tear line is arranged to form, from the first sheet a first sheet portion and from the second sheet a second sheet portion, where the two sheet portions are of identical shape and size, by tearing off side and end pieces."

As set forth above it is clearly the objective of Evers that a portion of one of the sheet portions be exposed above a top edge of the other to render it visible and accessible. It is therefore not disclosed in Evers nor is it obvious from Evers that two such sheet portions of identical shape and size be formed when the two portions are separated.

Again the Examiner has combined no prior art with Evers to disclose this feature and hence a prima facie case of obviousness has not been established. Even if the Examiner were to raise prior art such as Sanderson or Such, again it is clear that such prior art is inconsistent with the intended construction of Evers since it is an essential element of Evers that the pieces be of different shape as set forth above.

It is submitted therefore that claim 14 is also distinguished from the prior art and should therefore be allowed.

Turning now to claim 30, this claim includes the feature that

"The first and second sheets being arranged such that the indicia on the rear surface of the first sheet are covered by the second sheet and the indicia on the rear surface of the second sheet are covered by the first sheet."

It will be appreciated of course that the claim also states that each of the two sheets has indicia on the rear surface thereof.

Again this feature is not shown in Evers and is not obvious in view of Evers based upon the above stated arguments.

Turning now to **claim 33**, this claim does not include the features set forth above but is distinguished from the prior art of Evers by further features as explained below.

Thus claim 33 now includes the following features:

- a) The rear surface of both of the first and second sheets has printed indicia.
- b) The indicia defines at least one game to be defined by a user.
- c) The two sheets can be torn along the side edges of the bottom wall of the channel shaped receptacle to simultaneously remove the upstanding side walls leaving intact the bottom wall.
- d) The indicia for the game are printed only on the bottom portion and thus remain available for playing when the side walls are removed.

Evers clearly states in the paragraph bridging columns 4 and 5 that

"The removable portion of the inner frame includes the initially lower portions 40A of the front panel 40 as well as the initially lower portions of

the side panels 42 and 44". Thus the intention in Evers is that the line of weakness at which the folding of two portions occurs provides a tear line which allows the front portion to be removed to act as the coupon. This coupon will of course carry printed indicia as has been indicated by the Examiner and as disclosed in Evers.

The claim set forth above is distinguished from this prior art by the fact that the indicia for the game are confined solely to the center piece which defines the bottom portion so that the side walls can be torn away leaving merely the center portion which is in fact the bottom wall and when the side walls are torn away the portions still contain the indicia for the game. Yet further the indicia are printed on both of the portions on their rear surfaces.

Evers clearly does not disclose this feature. A rejection under 35USC102 is therefore no longer sustainable.

With regard to the possibility of rejection under 35USC103 is well established in MPEP that the Examiner must provide a second reference which discloses those features which are not included in the primary reference.

Even if the Examiner were to combine Evers with the break open tickets of Sanderson or Such, there is no disclosure that game indicia are printed on the inside surface of the first sheet.

Even if the Examiner were to combine the prior art of Evers with the prior art of Scrymgeour (US 6234477), there is no disclosure that tearing of the sheets at the side edges of the bottom portion would occur thus tearing away the side walls. Evers does not disclose any tearing in this area. Scrymgeour does

not disclose tearing of side walls but instead discloses tearing within one of the sheets.

It is submitted therefore that the construction set forth in claim 33 are properly distinguished from the prior art and should therefore be allowed.

Turning now to **claim 40**, this claim is distinguished from the prior art by yet further features as set forth as follows:

a) The indicia are printed on both the rear surfaces of both the first and second sheets.

b) The indicia comprise game indicia at least some of which is covered by a scratch off layer removable by the user.

This feature is clearly not disclosed in Evers and therefore rejection under 35USC102 is not proper in view of Evers. Further, rejection under 35USC103 is not proper since this feature is not disclosed in the prior art cited. It is well established in MPEP for a rejection under 35USC103 to be sustained all of the limitations of the claim must be found in one or other of the prior art documents cited.

The Examiner in this regard has merely stated that *"the provision of game indicia, promotional graphics, game information, variable image printing, etc. is of no patentable significance"*.

However the claim now clearly specifies that there is an additional element which is the scratch off coating removable by the player.

In order to sustain an objection under 35USC103 therefore, the Examiner must be able to cite additional prior art disclosing this feature and to

establish that there is motivation in either of the documents concerned to combine the documents.

The prior art of Sanderson and Such relates merely to break open tickets so that no scratch off coating is provided.

Evers merely discloses the provision of promotional coupons which contain additional information beyond that normally printed on the packet. There is simply no disclosure in Evers that the information may relate to a game having a scratch off coating.

It is admitted that game tickets are known (for example from Scrymgeour) which have game indicia covered by a scratch off coating. However there is no motivation in this prior art knowledge nor in the document of Evers to combine the game indicia with the scratch off coating into the construction of Evers.

It is submitted therefore that rejection of this claim under 35USC102 be sustained and that a rejection under 35USC103 is not proper in view of the absence of motivation.

It is submitted therefore that each of the independent claims is properly distinguished from the prior art and should therefore be allowed.

The Examiner will note that additional dependant claims have been added to depend from each of the above independent claims and these dependent claims correspond to those selected ones of the original dependent claims 2 through 12 which are relevant to the subject matter of the particular independent claim.

It is submitted therefore that the claims now presented herein are all therefore distinguished from the prior art and should therefore be allowed.

Respectfully submitted

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